

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 18, 19 and 23 will have been amended and claims 13-25 thus remain pending for reconsideration by the Examiner. The amendments to claims 18, 19 and 23 have not been made in view of the prior art but merely to enable the claim language to more properly describe Applicant's invention.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 18 and 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. By the present amendment, Applicant has amended claims 18 and 23 to clarify the scope of the invention. In particular, these claims now recite that the IP address of the scanner is utilized to transmit the IP address assigned to the terminal apparatus. Thus, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 13-25 under 35 U.S.C. § 103(a) as being unpatentable over CHOI (U.S. Patent Publication No. 2002/0040397) in view of MATSUURA (U.S. Patent Publication No. 2001/0021945).

As noted above, Applicant has amended claims 18, 19 and 23, and claims 13-25 remain pending. Applicant respectfully traverses the above rejection based on the pending claims 13-25 and will discuss the outstanding rejection with respect to these claims in the present application as will be set forth hereinbelow. The amendments to the claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 13-18 generally relate to a scanner apparatus which scans image data and comprises an interface configured to be connected to a terminal apparatus via a network. The terminal apparatus is configured to be connected to a DHCP (Dynamic Host Configuration Protocol) server via the network. The DHCP server assigns one IP address to the terminal apparatus. The one IP address is assigned to the terminal apparatus for a predetermined time period. The scanner apparatus also comprises a controller which receives, from the terminal apparatus, the one IP address assigned to the terminal apparatus, and transmits the scanned image data to the terminal apparatus during the predetermined time period, based on the received one IP address assigned to the terminal apparatus. Further, the controller receives, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, the another IP address being assigned to the terminal apparatus for a further predetermined time period by the DHCP server, and transmits the scanned image data to the terminal apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus. The another IP address is distinct from the one IP address. Claims 19-23

recite related terminal apparatuses. Claim 24 recites a related system. Claim 25 recites a related method.

Each of the Examiner's rejections applied against the pending claims is based on CHOI as the primary reference. However, Applicant notes that the CHOI reference is not available as a reference against the pending claims. The CHOI reference was published on April 4, 2002, and was filed in the U.S. Patent and Trademark Office on October 2, 2001. Thus, its availability as reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based on and enjoys the effective filing date of JP 2001-26850 which was filed on February 2, 2001, which is before the 35 U.S.C. § 102(e) date of the CHOI reference relied on by the Examiner.

Thus, Applicant submits that the CHOI reference is an inappropriate basis for the rejection of any of the claims in the present application. 35 U.S.C. § 102(e) specifies "the invention was described in --- a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent". Applicant notes that 102(e) does not apply to an application filed in a foreign country before the invention by the Applicant, but requires an application filed in the United States before the invention by the Applicant. Accordingly, under 35 U.S.C. § 102(e) CHOI is only entitled to his U.S. filing date of October 2, 2001. Thus, the CHOI reference is an inappropriate basis for the rejection of any of the claims in the present application. In other words, CHOI was filed after the invention defined by the pending claims, not "before the invention by the applicant for patent", as required for CHOI to come within the terms of 35 U.S.C. § 102(e).

In support of the above, Applicant is filing, concurrently herewith a certified English language translation of the priority document JP 2001-26850 to perfect Applicant's claim to the effective date of February 2, 2001.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 13-25 are not rendered unpatentable by the CHOI document cited by the Examiner, since CHOI is not available as a reference against the present application.

Independently of the above, Applicant submits that CHOI relates to an IP based network system which has a plurality of devices connected with one another and which includes a DHCP server for allocating a private IP address to the plurality of devices of the network system.

However, CHOI does not disclose a scanner apparatus which receive, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, the another IP address being assigned to the terminal apparatus for a further predetermined time period by the DHCP server, and transmits the scanned image data to the terminal apparatus during the further predetermined time period, based on the another IP address assigned to the terminal apparatus, the another IP address being distinct from the one IP address.

The Examiner asserts in the outstanding Official Action mailed on March 20, 2006 that one of ordinary skill in the art knows that the release process in DHCP allows an apparatus to receive a different IP address when the lease, which reads on the limitation as the predetermined time period, expires and this allows a different IP address to be assigned. However, the Examiner has not set forth any evidence in support of this assertion.

Thus, the pending claims are clearly distinguished over CHOI.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 13-25 are not disclosed in CHOI cited by the Examiner.

MATSUURA relates to a scanning device which receives, from a computer connected to a network, an IP address of the computer and a plurality of parameters for reading and encoding an image, and sends mail to the IP address of the computer with an attached file of read image.

However, MATSUURA does not disclose an interface which is connected to a terminal apparatus via a network, the terminal apparatus being configured to be connected to a DHCP (Dynamic Host Configuration Protocol) server via the network, the DHCP server assigning one IP address to the terminal apparatus, the one IP address being assigned to the terminal apparatus for a predetermined time period. MATSUURA does not contain any disclosures regarding a DHCP.

Additionally, MATSUURA also does not disclose a controller which receives, from the terminal apparatus, the one IP address assigned to the terminal apparatus, and which transmits the scanned image data to the terminal apparatus during the predetermined time period, based on the received one IP address assigned to the terminal apparatus.

MATSUURA further does not disclose a controller which receives, from the terminal apparatus, another IP address assigned to the terminal apparatus when the predetermined time period elapses, the another IP address being assigned to the terminal apparatus for a further predetermined time period by the DHCP server, and transmits the scanned image data to the terminal apparatus during the further

predetermined time period, based on the another IP address assigned to the terminal apparatus, the another IP address being distinct from the one IP address.

Thus, the pending claims are clearly distinguished over MATSUURA.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 13-25 are not disclosed in MATSUURA cited by the Examiner.

Thus, neither CHOI nor MATSUURA (nor, inherently, any combination of the two) teaches, in the claimed combination, the assignment of one IP address for a predetermined period of time and the assignment of another IP address for a further predetermined period of time, when the predetermined period of time elapses. Thus, no proper combination of CHOI and MATSUURA can be adequate to render Applicant's claims unpatentable, even if CHOI were available against the claims of the present application.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection, and requests an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims and submits the same for reconsideration by the Examiner. Applicant has perfected his claim for priority and has thus eliminated the availability of the cited document as a reference against any of the pending claims.

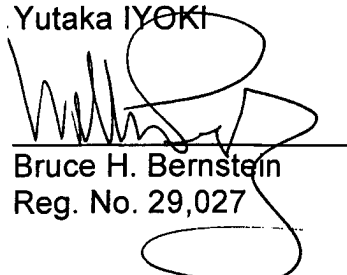
With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the claims with the disclosures of the applied references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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